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In the Supreme Court of the United States

OCTOBER TERM, 1958

WILLIAM DUBILIER, PETITIONER,

v.

THE UNITED STATES

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF CLAIMS

BRIEF FOR THE UNITED STATES IN OPPOSITION

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OPINION BELOW

The opinion of the Court of Claims (Pet. 18-22) is reported at 169 F. Supp. 489.

JURISDICTION

The final judgment of the Court of Claims was entered on January 14, 1959 (R. 49).[1] The petition for a writ of certiorari was filed on April 13,

[1] "(R.)" references are to the certified Transcript of Record; "(Tr.)" references are to the Transcript of Testimony.

1959.[2] The jurisdiction of this Court is invoked under 28 U.S.C. 1255(1).

QUESTIONS PRESENTED

1. Whether the Court of Claims erred in finding that the petitioner's evidence failed to establish an infringement of his patent claims by the Government's use of certain equipment and devices.

2. Whether the Court of Claims was precluded, as a matter of law, from disposing of an infringement suit on the ground of non-infringement, without considering the question of the validity of the patent, where the patent had expired prior to the institution of the suit.

STATEMENT

This suit was instituted on July 2, 1951, pursuant to 28 U.S.C. 1498,[3] to recover compensation for the

[2] The suit was filed in the Court of Claims in the name of Radio Patents Corporation, Patents Research Corporation, Radio Corporation of America, and William Dubilier, the latter being the sole petitioner here (R. 1). In accordance with a stipulation of the parties, the charge of infringement was restricted to a single patent issued to the Radio Patents Corporation, and the court found, as stipulated, that that corporation "was a party to this suit when filed and was the true party in interest thereto." (R. 53-54). Although not shown by the record, it is our understanding that petitioner is or was the sole stockholder of the corporation. We have no information as to why the petition has been filed in his name only.

[3] 28 U.S.C. 1498 provides in pertinent part:

> "Whenever an invention described in and covered by a patent of the United States is used or manufactured by or for the United States without license of the owner thereof or lawful right to use or manufacture the same, the owner's remedy shall be by action against the United States in the Court of Claims for the recovery of his reasonable and entire compensation for such use and manufacture."

unlicensed use by the Government of certain electronic equipment allegedly covered by six claims of patent No. 1,898,046 (the Geffcken patent) (R. 1-5). The patent was issued on February 21, 1933, to the Radio Patents Corporation, and expired on February 21, 1950 (R. 56).

The Government contended that the patent claims in question had not been infringed and that, for several reasons, the claims were not valid (R. 49). These defenses were, in all material respects, accepted by the Commissioner of the Court of Claims, who found all of the claims invalid as anticipated by the prior art, three of the claims invalid as unsupported by the electronic circuits disclosed in the issued patent, and none of the claims infringed by the accused structures (R. 9-46). The Court of Claims agreed with the Commissioner's conclusions on non-infringement, and accordingly found it unnecessary to pass upon the patent's validity (R. 53).

The subject of the Geffcken patent is "Electric Relay Device for Indicating Weak Currents." Petitioner contended that this device was employed by the Government in various gas-containing electronic tubes and associated circuits (R. 49). In rejecting these contentions, both the Commissioner and the Court of Claims found that the evidence introduced by petitioner, principally in the form of expert testimony, did not establish that the distinctive elements of the patented invention were used in the Government's equipment. These findings (R. 53-73) may be summarized as follows:

1. The first accused structure was part of an Air Force turret controller containing a complex multitube circuit (R. 68-69). Petitioner contended that one of

the thirty or more tubes of this apparatus (a power thyratron designated *V102*), and its associated circuits (transformers, resistances, condensers), infringed all of the patent claims in suit. After reviewing the nature of the tube and its circuits, the court concluded that none of the claims had been infringed since petitioner had failed to establish that certain of its elements were contained in the structure. Specifically, the evidence was found to be inconclusive as to (a) whether the energy supply of the *V102* is of too low a value normally to cause the gas in the tube to ionize and to start an arc discharge (a luminous bow of light between two electrodes passing a relatively high value of electric current at low voltages); (b) whether the voltage on the grid of the *V102* is of such a value that the tube would become ionized and an arc discharge occur between the tube's grid and cathode upon imposition of a low additional controlling potential; (c) whether the tubes in the Air Force device provide an auxiliary discharge space formed by an auxiliary electrode, and whether an ionizing discharge exists in such space if provided; (d) whether the tubes are provided with a condenser in parallel with the main electrodes at the auxiliary gap; (e) whether the tubes have a uniform gaseous atmosphere; and (f) whether they have a potential means in the output circuit for alternately starting as well as stopping a discharge.

2. The second accused structure was the Rawin Apparatus elevation drive motor control circuit, used by the Army and providing for the control of current flow to the stator windings of a direct current motor (R. 69-71). The circuit of this device includes two gas-filled tubes designated *V603* and *V604*. Petitioner's

evidence was found to be inconclusive as to (a) whether, as with the *V102*, the voltage on the control grid is of such a value that upon imposition of a low additional controlling potential, a low voltage arc occurs between the control grid and cathode; (b) whether the tubes are glass; (c) whether the control grid is arranged to form an auxiliary discharge space together with the cathode, and whether an ionizing discharge exists in such space if provided; (d) whether the circuit includes a condenser in parallel with the main electrodes; (e) whether the tube contains a uniform gaseous atmosphere in view of the fact that mercury pool cathodes are employed; (f) whether the circuit includes an electric reactance associated with an input circuit and connected to an auxiliary electrode; and (g) whether the circuit includes potential means in the output circuit for alternately starting as well as stopping an electric discharge.

3. The third accused structure was a Navy auxiliary control panel, employing a vacuum tube marked *V19* (R. 71-72). The tube, as shown by relatively low maximum-peak current limits and high voltage drop during conduction, is a glow discharge device (a luminous glow or haze between two electrodes passing minute values of current at relatively high voltages). Accordingly, it could not be used for arc conduction as required by the patent claims. Petitioner's contention that, when used in the control panel circuit, the tube might operate in arc discharge was rejected as unsupported by the evidence. Although petitioner had called one fact witness and three expert witnesses on this point, no coherent explanation was made of the tube's operation in the circuit, or of the nature of the other

circuits or apparatus with which the relay circuit of the control panel was used. There was no evidence as to the value or values of any potentials connected to the numerous terminals and no evidence of a potential means in the output circuit for alternately starting as well as stopping the electric discharge.

4. The final accused structure was a Navy Resistance Welding Control, containing a gas-filled tube designated *4TU* (R. 72). As with the tubes contained in the first three structures, the evidence was inconclusive as to whether this tube is caused to fire by imposition of a low additional, or an extremely weak, controlling potential upon an auxiliary potential already imposed on the grid electrode. Such a possibility would be extremely remote since petitioner's own exhibit showed that the structure employs a grid bias supplied from a 60-volt source and a control potential from a 230-volt source.

5. Perhaps the most distinctive feature of the Gefficken invention is the use of a cold cathode and an external circuit which makes the cold cathode arc (R. 50). Petitioner's counsel himself pointed this out in his opening statement before the Commissioner (R. 73). The specification of the Gefficken patent does not teach the use of a hot cathode or a thermionic (heated) filament type cathode (tubes which employ thermionic means to emit electrons which provide the path for the flow of electricity). All of the accused structures, with the exception of the Navy auxiliary control panel, clearly utilize tubes having thermionic filaments providing a hot cathode. Thus, it must be concluded, an essential element of the patented invention, along with its possible advantages,

was not employed in three of the four Government devices accused.

The Navy auxiliary control panel admittedly utilizes a cold cathode but lacks the necessary circuit to produce an arc discharge. It utilizes a tube described as a vacuum tube in the manufacturer's own specifications, whereas one of the principal features of the Gefficken patent is the use of a gas-filled tube (R. 73). Thus, this control panel, too, does not infringe any of the patent claims in suit.

ARGUMENT

1. Petitioner's own statement (Pet. 5-10) of the first issue which he seeks to have determined demonstrates that he raises neither a question of general importance nor one involving a conflict of decisions requiring resolution by this Court. Rather, he seeks nothing more than to have this Court review the record, and to hold, after conducting such a review, that the findings of fact made by the Commissioner and adopted by the Court of Claims—that none of the patent claims was in fact infringed by the accused structures—are unsupported by the evidence. Furthermore, in urging that there is no basis for these findings, petitioner argues that the court below was legally required, in the absence of contrary evidence, to accept the conclusions of his expert witnesses, a contention which wholly ignores the freedom of the trier of fact to find that particular evidence is inconclusive or unpersuasive.

This Court has held that, in an infringement suit which centers upon the testimony of expert and other witnesses, questions of validity and infringement are questions of fact, not of law. *United States* v. *Esnault-*

Pelterie, 303 U.S. 26, 29-30. As to such questions, the normal limitations on appellate review of factual findings have especial significance, for "* * * so much depends upon familiarity with specific scientific problems and principles not usually contained in the general storehouse of knowledge and experience." *Graver Mfg. Co.* v. *Linde Co.*, 339 U.S. 605, 610.

Although it is clear that petitioner's attack on all of the findings of the court below is ill-founded, the single example chosen by petitioner from the record will serve to illustrate our point (Pet. 5-6). The Court of Claims ruled with respect to the tubes used in the Air Force turret controller (the first accused structure, pp. 3-4, *supra*), that "We are not able to find any basis for departing from our trial commissioner's finding that this controller circuit does not respond to the specific recital of claim 18," namely, "a potential means in the output circuit for alternately starting and stopping the electric discharge * * *." (R. 51; Pet. 20). In the face of this finding, petitioner points to the uncontradicted testimony of an expert witness that "The co-joint action of the shunt condenser C121 and the series resistor R119 effectuates the alternate starting and stopping of the discharge tube V107 during its firing state, namely, when the tube would tend to or want to conduct, it is alternately interrupted by those two elements * * * as the Government [sic] witness yesterday very clearly and ably set forth" (Tr. 147). But petitioner's patent expert, although later qualified as a technical expert, was not qualified to establish operation of the accused structures in the terms of the claims (Tr. 133, 632-33, 634). He relied on the testimony of another witness given on

the previous day. This reliance was quite erroneous, for that witness had stated (in answer to leading questions from petitioner's counsel) only that the discharge might be stopped sometime after it was started, not that the tube current was alternately interrupted, *i.e.*, started and stopped (Tr. 41-42).[4] And in giving this testimony, the witness asserted that whether the circuit would perform the former function "* * * is rather difficult for me to say"; "It looks very much like it would" (*ibid.*). Thus, when properly analyzed, it is plain that it was perfectly sound for the Court of Claims to conclude that the evidence was "inconclusive as to whether the controller thyratrons [have the alternate interruption means] recited in claim 18", (R. 69).

2. Petitioner's contention that the Court of Claims committed reversible error in deciding the case on the ground of non-infringement, without considering the question of the validity of the patent, misconceives *Sinclair & Carroll Co.* v. *Interchemical Corp.*, 325 U.S. 327. In that case, the District Court had held a patent invalid and non-infringed; the Court of Appeals reversed, holding the patent both valid and infringed; and this Court reinstated the District Court judgment on the ground of invalidity alone, without reaching the question of infringement (which was, of course, rendered moot by the decision). No part of the Court's holding requires, as a matter of law, that the question of validity always be considered first before a finding of non-infringement can be made. The Court simply

[4] The witness affirmatively answered the following question: "* * * you do need in the case of tube V107 something which will bring the plate voltage below the ignition point: is that correct?"

stated, in the portion of its opinion quoted by petitioner (Pet. 10-11), that since the question of validity has the greater public importance, the better practice is *usually* to inquire fully into that question. The lower federal courts have consistently given this Court's language its obvious meaning and have held this to be a cautionary admonition rather than a peremptory direction—at most, a requirement that courts strike down clearly invalid patents when it is in the public interest to do so. *E.g., Hutchens* v. *Faas*, 249 F. 2d 465, 467 (C.A. 9); *Kemart Corp.* v. *Printing Arts Research Laboratories*, 201 F. 2d 624, 634 (C.A. 9); *Dow Chemical Co.* v. *Skinner*, 197 F. 2d 807, 811-12 (C.A. 6), certiorari denied, 344 U.S. 856; *Patent Scaffolding Co.* v. *Up-Right, Inc.*, 194 F. 2d 457, 461-62 (C.A. 9), certiorari denied, 343 U.S. 958; *Harries* v. *Air King Products Co.*, 183 F. 2d 158, 161-63 (C.A. 2); cf., *Altvater* v. *Freeman*, 319 U.S. 359, 363; *Electrical Fittings Corp.* v. *Thomas & Betts Co.*, 307 U.S. 241. In the *Harries* case, *supra*, Judge Learned Hand stressed the importance of permitting a court, in its discretion, to choose the more convenient course in a particular case, since disposing of a suit on the ground of non-infringement avoids what may be the extremely difficult task of reconstructing the prior art and of attempting to resolve such vague and elusive questions as whether the prior art has been significantly improved upon. After considering this Court's decision in *Sinclair & Carroll*, Judge Hand stated, "We hold that it is open to a court to proceed as is most convenient, subject to the exception that, though the defendant has not infringed, claims may be so evidently invalid that the court should so declare." 183 F. 2d at 163.

In the present case, wholly apart from these considerations, there was a simple and clear reason for the Court of Claims to base its decision on non-infringement rather than on invalidity. As noted *supra*, p. 3, the patent in question had expired on February 21, 1950, prior to the time this suit was instituted. Obviously, any overriding consideration stemming from the public interest in an adjudication of validity or invalidity cannot be applied to a patent which has expired and long since cease to preclude the unlicensed manufacture and use of similar devices.

CONCLUSION

For the foregoing reasons, it is respectfully submitted that the petition for a writ of certiorari should be denied.

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